

REMARKS

The Office Action of June 24, 2008 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Applicants respectfully note that the Examiner failed to indicate that prior claim rejections under 35 USC §112, second paragraph, and 35 USC §102(b) have been withdrawn. The new rejections as set forth in the current office action are based only on 35 USC §103(a).

Turning now, to the office action, Claims 1-13, 15 and 17-19 were rejected under 35 USC §103(a) as being obvious in view of Tagami et al., US Patent No. 5,237,425 (hereinafter "Tagami") and Yoshida et al., US Pub. No. 2005/01714586 A1 (hereinafter "Yoshida"). Claims 14 and 16 were rejected under 35 USC §103(a) as being unpatentable over Tagami in view of Yoshida and further in view of Draaisma, US Pub. No. 2003/0227638 A1 (hereinafter "Draaisma").

Arguments in Traversal of Rejections

The disclosures of the cited art and the distinctions between the cited patents and publications may be briefly summarized as follows:

Claims 1-13, 15 and 17-19 were rejected under 35 USC §103(a) as being obvious in view of Tagami and Yoshida. Considering, first, independent claim 1, Applicants respectfully submit that the rejection fails to set forth a *prima facie* case of obviousness by teaching all the limitations recited in claim 1. In setting forth the rejection of claim 1, the Examiner has identified a number of references to Tagami. As set forth, Applicants urge that Tagami generally discloses a compiler for producing, from an Ink Source Language, a catalog of colors using two colorants (e.g., black plus highlight color) for use in a printer. Tagami states, for example at col. 1, lines 5-10, that it is directed to a "method of creating catalogs of colors for a printer capable of printing in two colors..." Nonetheless, the Examiner urges that col. 8, lines 36-42 of Tagami (which refers to Fig. 13 and the definition of color "only us[ing] black plus one other color") somehow teaches mapping from a two color input to a full color space (at least three colors) by applying a mapping function. Applicants respectfully urge that the Examiner has misinterpreted the teachings of Tagami. While Tagami does refer to RGB (not in col. 8 as alleged), it is not believed

to be in the context of teaching mapping the input data for each of a primary and highlight color to an equivalent full color space by applying a first mapping function, as recited in claim 1. Hence, Tagami is urged as failing to teach that which it has been relied upon as the basis for the rejection. Nor does Yoshida appear to teach mapping two-color input to an equivalent color defined in the full color space by applying a first mapping function to each color of the two-color input data as recited in claim 1.

Tagami is now acknowledged as failing to teach several of the limitations set forth in claim 1. However, in the instant office action, Yoshida has been alleged as giving rise to such limitations. In addition to failing to teach a first mapping function as set forth above, Applicants further urge that Yoshida fails to teach "representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space," as recited in claim 1. Applicants are unable to find such a reference in paragraphs 8 – 11 as suggested. Moreover, an automated word search indicates that the term "intermediate output" does not appear anywhere in Yoshida's nearly 300 paragraphs. Just what does the Examiner rely upon for teaching the recited limitations? In the event the rejection is maintained, Applicants respectfully request that the Examiner set forth with specificity where the limitations of the rejected claims are found in the various references relied upon.

In addition to demonstrating that Tagami and Yoshida, alone and in combination, fail to teach several of the limitations set forth in independent claim 1, Applicants further urge that the Examiner failed to establish a basis for the combination. Rather than identify a basis for the combination, the rejection largely recites Applicants claim limitations (see top. p. 4) adding an unsupported and conclusory statement that it would have been obvious to combine the teachings "in order to improve the efficiency and accuracy of the system by adding an intermediate value for processing." (underlining added as emphasis; the Examiner suggests a system when claim 1 is directed to a method) If neither Tagami or Yoshida teach or suggest the intermediate value, what does the Examiner rely on to urge it would have been obvious to combine the references? Moreover, where does the Examiner allege support that the alleged combination would improve efficiency or accuracy as has been alleged? Applicants respectfully contend that it would not have been obvious to combine or

modify the references and that the Examiner has improperly used the claim limitations as a “recipe” by which unrelated teachings were combined to arrive at the claimed invention. Accordingly, *prima facie* obviousness has not been established, and claim 1 is believed to be in condition for allowance.

Relative to independent claim 6, Applicants respectfully incorporate the arguments above with respect to the similar limitations found in claim 6. Applicants further urge that the Examiner has improperly attempted to engage in piecemeal reconstruction of the limitations of claim 6. For example, finding a reference to “zero” at col. 8, lines 41 and 58, the Examiner incorrectly concludes that Tagami somehow teaches the limitation of “if the lesser value screen characteristic is zero, generating an intermediate output that is a function of only one of the primary and secondary colors, otherwise, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage,” as recited in claim 6. Applicants respectfully disagree and request that the Examiner consider the teaching in the context in which it is presented – in relation to the description of the bytes used for a color description.

As for the teaching of Yoshida alleged at p. 6 of the office action, the Examiner acknowledges several aspect of claim 6 that are not taught by Tagami but then, to the best Applicants can understand, seems to urge that the limitations are again taught by paragraphs 8 – 11 of Yoshida. Applicants respectfully question where in Yoshida the limitations of “generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage” are taught. Applicants are unable to identify such teachings in the cited paragraphs or elsewhere. Moreover, Applicants find no reference to percentages as set forth in the claim. In light of the various failures noted relative to the rejection of claim 6, Applicants again urge that *prima facie* obviousness has not been established so as to permit, or require, Applicants to further respond thereto.

Considering independent claim 15, Applicants respectfully incorporate the arguments set forth above relative to claims 1 and 6, which are believed to similarly characterize the failure of any alleged combination of Tagami and Yoshida to teach the limitations set forth therein. In light of the failure of Tagami and/or Yoshida to teach limitations

such as “determining, for each color of the two-color input data, an equivalent color defined in a full color space by applying a first function to each color of the two-color input data” and “if the lesser screen characteristic is zero, generating an intermediate output that is a function of only one of the primary and secondary colors, otherwise, generating an intermediate output that is a function of both the primary and secondary colors, wherein the intermediate outputs include a highlight color, a highlight color percentage and a black percentage,” among others, Applicants urge that *prima facie* obviousness has not been established. Claim 15 is respectfully urged to be in condition for allowance.

As for dependent claims 2-5, 7-13 and 17-19, these claims all depend from now presumably allowable amended claims 1, 6 or 15, and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to the independent claims. For purposes of brevity specific arguments of patentability are not presented herein but are respectfully reserved for a subsequent response or on appeal.

Claims 14 and 16 were rejected under 35 USC §103(a) as being unpatentable over Tagami in view of Yoshida and Draaisma. Claims 14 and 16 are both dependent from independent claims 6 or 15, respectively, as discussed above. Applicants respectfully refer to the arguments in traversal of the rejection based upon Tagami and Yoshida as incorporated herein. In addition to the distinctions noted relative to Tagami and Yoshida, those and additional limitations of the claims are not believed to be fulfilled by the teachings of Draaisma. Draaisma also fails to teach what has been alleged as the basis for the rejection of the limitations in claims 14 and 16. Claims 14 and 16 require that the data representing a single color defined in at least three color space represented in an extensible markup language schema (e.g., claim 14). While Draaisma does teach XML as one of a number of structured formats for use with images, Applicants respectfully submit that this does not rise to the level of teaching the limitations of claims 14 and 16. Accordingly, the rejection is respectfully traversed.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 24-0037 for Xerox Corporation.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

/Duane C. Basch, Esq. Reg. No. 34,545/

Duane C. Basch
Attorney for Applicant
Registration No. 34,545
Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970

DCB/dcm